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10/658,084
TP2686USNA

REPLY BRIEF UNDER 37 C.F.R. §41.41
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RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 1733
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE APPLICATION OF:

RAYMOND JOSEPH REISDORF ET. AL.

CASE NO.: **TP2686USNA** APPLICATION NO.: **10/658,084**

CONFIRMATION NO.: **1439** GROUP ART UNIT: **1733**

EXAMINER: **SAMCHUAN CUA YAO** FILED: **SEPTEMBER 9, 2003**

FOR: **PROCESS FOR PRODUCING CARPET**

REPLY BRIEF UNDER 37 C.F.R. §41.41

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Examiner's Answer mailed 7 September 2005 as to the above-referenced application, Appellants submit the following Reply Brief.

ARGUMENT

Appellants provide the following arguments in response to comments made in the Examiner's Answer.

At page 12 of the Examiner's Answer, the Examiner criticizes the Reisdorf Declaration evidence for failing to provide examples which are "commensurate in scope with the claims", i.e. that the Reisdorf Declaration provided only examples having adhesive melt indices at 400.

The Reisdorf Declaration was provided not so much to demonstrate "unexpected results", but instead to demonstrate that the examples of WO '806 do not achieve the goal stated in the present application, which is to reduce fiber pull-out, as evidenced by the Lisson Tretrad testing data in the Declaration. Appellants are fully justified in testing against the closest compounds actually taught in the reference, and not required to create "prior art" examples. Ex parte Westphal, 223 USPQ 630 (BPAI 1983). Appellants have demonstrated that the "closest prior art" example does not function in the manner of the presently claimed invention, and therefore should not be under the onus of demonstrating the operability of that which they have declared (in the Inventors' Declaration) to be true.

Turning now to the Reith reference, the Examiner cites Reith for the proposition that it would have been obvious to use a lower viscosity adhesive composition in carpet manufacture such that during the finishing step the adhesive flows into and around the tuft stitches and the primary backing to securely bond the tufts in the carpet structure and resist tuft pull-out (Examiner's Answer, page 5, bottom).

Appellants take issue with Reith on several levels. First, Reith makes no mention of achieving the goals of the present invention, i.e. to resist the pull-out of individual fibers, as demonstrated by the Lisson Tretrad test. Instead, Reith addresses only resistance to tuft pull-out, which is the object of the primary reference, WO '806. Accordingly (and second), Reith is silent about forcing his adhesive between the tuft fibers themselves, but only speaks to causing the adhesive to flow "into and around the fibers or yarns of the backings and tuft stitches" (col. 5, lines 14-17; emphasis added). Thus, it is clear that Reith fails to even appreciate the deficiencies of WO '806 relating to individual fiber pull-out from the tufts, which are addressed by Appellants' invention, and as such the skilled artisan would have no

motivation to modify WO '806 in the manner of Reith as suggested by the Examiner. As such, Appellants submit that the combination of WO '806 and Reith is improper and does not support a *prima facie* case of obviousness as to the present claims.

Third, even if such a motivation could be derived from Reith, Appellants submit that the Examiner has mischaracterized the significance of the Reith teachings. At page 14 of the Examiner's Answer, the Examiner points out that Reith teaches the use of an EVA-based adhesive having a melt index of about 100 to about 400 g/10 min, citing to col. 7, lines 26-51. However, what the Examiner fails to mention is that the Reith adhesive contains significant quantities of additional components, which call into question the ultimate viscosity of the Reith adhesive composition and its suitability for melt-extrusion. In addition to the limitations cited by the Examiner, Reith discloses that his preferred adhesive composition contains: 30-40 wt% of said EVA-based adhesive; 30-40 wt% of a synthetic polyterpene resin; 10-25 wt% of microcrystalline wax; and about 5-15 wt% of a polybutene plasticizer (col. 7, lines 26-40). Thus, even if the skilled artisan would have been motivated to select adhesives of the particular melt index range of Reith to modify WO '806, he would have also have been motivated to include the other components of the Reith adhesive composition.

> When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:
> (A) The claimed invention must be considered as a whole;
> (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
> (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
> (D) Reasonable expectation of success is the standard with which obviousness is determined. (MPEP 2141, citing Hodosh v. Block Drug Co., Inc. 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986) (Emphasis added).

In this instance, rather than considering the Reith reference as a whole, the Examiner has cherry-picked from Reith only the language which suits the proposed combination of references. Considering the Reith reference as a whole, the skilled artisan would substitute the Reith adhesive composition, with all its components, for that of WO '806, which result would still not meet the limitations of present claim 1, which requires at least 85 wt% of an ethylene copolymer or terpolymer with a

carboxylic acid. Reith would suggest incorporation of only 30-40 wt% of an EVA-based adhesive.

> [T]he prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. MPEP § 2142, citing In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); emphasis added.

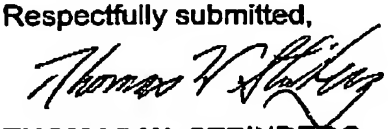
Fourth, a teaching of the suitability of the Reith adhesive compositions for melt extrusion onto a carpet backing, as in WO '806, is clearly lacking. In fact, melt extrusion is exactly the process which Reith is attempting to replace.

> A further object of the invention is to provide a hot melt adhesive carpet lamination process in which use of molten adhesives and equipment for application thereof is eliminated. (Column 4, lines 37-40).

Accordingly, Appellants submit that this is another instance of the Examiner not considering the reference teachings "as a whole", and that those of skill in the art would not have looked to Reith to modify hot melt adhesive compositions for melt extrusion, as performed in WO '806. Reith is essentially non-analogous art to WO '806, and as such is improperly combined with WO '806. Such combination cannot be said to support a *prima facie* case of obviousness as to the present claims.

As such, the cited references are improperly combined, and even in combination, would not make obvious the claims of the present application. Withdrawal of the rejection and allowance of the claims is requested.

Respectfully submitted,



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Dated: 9/16/05

TWS:kl